

**REMARKS****Summary of the Office Action**

Claim 8 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,398,214 to *Motek et al.* ("*Moteki*").

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,220,592 to *Watanabe et al.* ("*Watanabe*").

Claims 1, 3-5, and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of U.S. Patent No. 6,371,471 to *Fukazu et al.* ("*Fukazu*").

The indicated allowability of claims 1, 3-5, and 12-14 in the previous Office Action is withdrawn in view of newly discovered references.

**Summary of the Response to the Office Action**

Applicant amends claims 1, 6, and 8. Claims 2, 7, 9-11, and 15-23 are cancelled, without prejudice or disclaimer. Accordingly, claims 1, 3-6, 8, and 12-14 are presently pending.

**All Subject Matter Complies with 35 U.S.C. § 112, second paragraph**

Claim 8 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Applicant has amended claim 8 in order to expedite the prosecution of this case.

Applicant respectfully submits that the amendments to claim 8 do not narrow the intended scope of the claim, and therefore, Applicant does not intend to relinquish any subject matter by these amendments. Applicant respectfully submits that claim 8 meets all the requirements of 35 U.S.C. § 112, as amended. Thus, the rejection of claim 8 under 35 U.S.C. § 112, second paragraph, is moot. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

**All Subject Matter Complies with 35 U.S.C. § 102(b)**

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Moteki*.

Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that the Office Action has not established that *Moteki* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Independent claim 6 recites, in part, "a longitudinal alignment portion that gives a conveyance force to sheets sequentially supplied to the compiling tray to push the supplied sheets against the longitudinal reference wall, the longitudinal alignment portion being a paddle member; and a controller that controls a position of the longitudinal alignment portion in a direction of thickness of sheets stacked on said compiling tray." *Moteki* fails to teach or suggest at least these features of claim 6.

The Office Action equates the longitudinal alignment portion with the return roller 50 of *Moteki*. Claim 6 calls for "the longitudinal alignment portion being a paddle member." By contrast, *Moteki*'s return roller can hardly be considered a paddle member. See col. 7, lines 36-48 of *Moteki*. Accordingly, *Moteki* fails to teach or suggest each and every feature of claim 6.

Thus, the rejection of claim 6 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Moteki* does not teach or suggest each feature of independent claim 6.

Additionally, Applicant respectfully submits that dependent claim 8 is also allowable insofar as it recites the patentable combinations of features recited in claim 6, as well as reciting additional features that further distinguish over the applied prior art. Claim 7 and 9 are canceled without prejudice or disclaimer.

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Watanabe*. Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that the Office Action has not established that *Watanabe* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 6 recites, in part, "wherein the longitudinal alignment portion conveys the sheet to said longitudinal reference wall by using a member that turns by simultaneously touching a surface of said sheet when placed at a sheet alignment position, and wherein said longitudinal alignment portion once moves from said sheet alignment position to a sheet pressing position in synchronization with predetermined sheet conveying timing, and then returns to said sheet alignment position." *Watanabe* fails to teach or suggest at least these features of claim 6.

The Office Action equates the longitudinal alignment portion with the paddle 31 of *Watanabe*. But the Office Action does not adequately explain how the paddle 31 moves from the sheet alignment position in Fig. 15 to the sheet pressing position in Fig. 13. See col. 11, lines 31-59 of *Watanabe*. Further, the Office Action does not explain how “said longitudinal alignment portion once moves from said sheet alignment position to a sheet pressing position in synchronization with predetermined sheet conveying timing, and then returns to said sheet alignment position,” as recited in newly amended claim 6. That is, the Office Action recites the claim language and points to Figs. 13 and 15 of *Watanabe*, but it does not explain or cite any part of the *Watanabe* specification where it describes the alleged features. Accordingly, *Watanabe* fails to teach or suggest each and every feature of newly amended claim 6. Thus, the rejection of claim 6 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Watanabe* does not teach or suggest each feature of independent newly amended claim 6.

Additionally, Applicant respectfully submits that dependent claim 8 is also allowable insofar as it recites the patentable combinations of features recited in newly amended claim 6, as well as reciting additional features that further distinguish over the applied prior art. Claims 7 and 9 are cancelled, without prejudice or disclaimer.

Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 102(b) be withdrawn.

**All Subject Matter Complies with 35 U.S.C. § 103(a)**

Claims 1, 3-5, and 12-14 stand rejected 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of *Fukazu*. Applicant respectfully traverses the rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because *Watanabe* and *Fukazu*, whether alone or in combination, fail to teach or suggest all the recited features of independent claims 1 and 12. Newly amended independent claim 1 recites, in part, “advancing and retracting operations of said pressing member vary according to whether or not folding is performed on sheets newly supplied to said compiling tray; said pressing member is provided at a downstream side of a supplying direction of said sheets above said compiling tray.” Similarly, independent claim 12 recites, in part, “a conveyance force of said second moving-aside unit is used for moving said sheets aside toward said longitudinal reference wall, and set therein in such a way as to be variable; and said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on said compiling

tray.” *Watanabe* or *Fukazu*, whether taken alone or in combination, fail to teach or suggest at least these features of claims 1 and 12.

The Office Action equates the movable delivery roller 17b as the claimed pressing member. Contrary to the assertions in the Office Action, *Watanabe*’s movable delivery roller 17b is not “said pressing member [] provided at a downstream side of a supplying direction of said sheets above said compiling tray.” See col. 7, lines 22-50 of *Watanabe*. As can be seen in Figs. 13-15 of *Watanabe*, the movable delivery roller 17b is a part of rocking guide 20 and it is provided at an upstream side of a supplying direction of said sheets, not a downstream side. Accordingly, *Watanabe* fails to teach or suggest each and every feature of claim 1. *Fukazu* does not cure this deficiency in *Watanabe*. Thus, the rejection of claim 1 should be withdrawn.

Further, the Office Action states “*Watanabe et al.* does not specifically show that the second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on the compiling tray.” It relies upon *Fukazu* for this teaching. Contrary the assertions in the Office Action, *Fukazu* does not provide this teaching either. Applicant respectfully request that the Examiner provide reference to *Fukazu* where it is taught that the moving-aside unit varies according to whether or not folding is performed. Assumptions are not evidence of this teaching. Accordingly, *Watanabe* fails to teach or suggest each and every feature of claim 12. *Fukazu* does not cure this deficiency in *Watanabe*. Thus, the rejection of claim 12 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because

*Watanabe* and *Fukazu*, whether taken alone or in combination, fail to teach or suggest each feature of independent claims 1 and 12, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 3-5 and 13-14 depend from one of independent claims 1 or 12. Accordingly, claims 3-5 and 13-14 are also allowable because of the additional features they recite and the reasons stated above.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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